

PATENT COOPERATION TREATY

TRANSLATION

From the
INTERNATIONAL SEARCHING AUTHORITY

PCT

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

(PCT Rule 43bis.1)

To:

Date of mailing
(day/month/year)

Applicant's or agent's file reference

04016-PCT

FOR FURTHER ACTION

See paragraph 2 below

International application No.

PCT/JP2004/009238

International filing date (day/month/year)

23.06.2004

Priority date (day/month/year)

23.06.2003

International Patent Classification (IPC) or both national classification and IPC

Applicant

TORAY INDUSTRIES, INC.

1. This opinion contains indications relating to the following items:

- ☒ Box No. I Basis of the opinion
- ☐ Box No. II Priority
- ☐ Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- ☒ Box No. IV Lack of unity of invention
- ☒ Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- ☒ Box No. VI Certain documents cited
- ☐ Box No. VII Certain defects in the international application
- ☐ Box No. VIII Certain observations on the international application

2. **FURTHER ACTION**

If a demand for international preliminary examination is made, this opinion will be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA") except that this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1bis(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of 3 months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

3. For further details, see notes to Form PCT/ISA/220.

Name and mailing address of the ISA/JP

Authorized officer

Facsimile No.

Telephone No.

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

International application No.

PCT/JP2004/009238

Box No. I

Basis of this opinion

1. With regard to the language, this opinion has been established on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.

☐

This opinion has been established on the basis of a translation from the original language into the following language

_____, which is the language of a translation furnished for the purposes of international search (under Rule 12.3 and 23.1(b)).

2. With regard to any nucleotide and/or amino acid sequence disclosed in the international application and necessary to the claimed invention, this opinion has been established on the basis of:

a. type of material

☐

a sequence listing

☐

table(s) related to the sequence listing

b. format of material

☐

in written format

☐

in computer readable form

c. time of filing/furnishing

☐

contained in the international application as filed.

☐

filed together with the international application in computer readable form.

☐

furnished subsequently to this Authority for the purposes of search.

3. ☐ In addition, in the case that more than one version or copy of a sequence listing and/or table(s) relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.

4. Additional comments:

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

International application No.

PCT/JP2004/009238

Box No. IV Lack of unity of invention

1. ☐ In response to the invitation (Form PCT/ISA/206) to pay additional fees the applicant has:
- ☐ paid additional fees
 - ☐ paid additional fees under protest
 - ☐ not paid additional fees
2. ☒ This Authority found that the requirement of unity of invention is not complied with and chose not to invite the applicant to pay additional fees.
3. This Authority considers that the requirement of unity of invention in accordance with Rules 13.1, 13.2 and 13.3 is
- ☐ complied with
 - ☒ not complied with for the following reasons:

A matter common to claims 1-18 is the adhesive composition described in claim 1, i.e., "an adhesive composition for semiconductor devices, characterized in that it comprises at least an epoxy resin, a phenoxo resin, and a hardener and that part or all of the epoxy resin comprises at least one epoxy resin selected among the following: (a) epoxy resins modified with a dimmer acid, and (b) phosphorous-containing epoxy resins having an epoxy equivalent of 2×10^3 to 6×10^3 ." However, as a result of an international search, it was found that the common matter is neither novel nor involves an inventive step because it is disclosed in the documents shown in the attached sheet or it has been easily attainable by persons skilled in the art based on inventions disclosed in the documents. The matter cannot be regarded as a special technical feature in the meaning of Rule 13.2 of the Regulations under the PCT. Furthermore, no other common matter appears to exist that is considered to be a special technical feature. It cannot hence be considered that claims 1-18 is a group of inventions so linked as to form a single general inventive concept.

4. Consequently, this opinion has been established in respect of the following parts of the international application:
- ☒ all parts
 - ☐ the parts relating to claims Nos. _____

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

International application No.

PCT/JP2004/009238

Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

| | | | |
|-------------------------------|--------|---------------------|-----|
| Novelty (N) | Claims | <u>2, 7, 8</u> | YES |
| | Claims | <u>1, 3-6, 9-18</u> | NO |
| Inventive step (IS) | Claims | <u>2, 7, 8</u> | YES |
| | Claims | <u>1, 3-6, 9-18</u> | NO |
| Industrial applicability (IA) | Claims | <u>1-18</u> | YES |
| | Claims | | NO |

2. Citations and explanations:

Document 1: JP 2001-181375 A (Ajinomoto Co., Inc.), 03 July 2001
Document 2: JP 2000-277925 A (Sumitomo Bakelite Co., Ltd.), 06 October 2000
Document 3: JP 2000-273429 A (Sumitomo Bakelite Co., Ltd.), 03 October 2000

Each invention of claims 1, 3-6, and 9-18 do not appear to be novel or to involve an inventive step based on the contents disclosed in the above documents 1-3 cited in the ISR.

Documents 1-3 pertain to an adhesive composition respectively containing an epoxy resin such as a bisphenol type, a phenoxy resin, and a hardener, and useful in electrical purpose, wherein a phosphorous-containing epoxy resin made by modifying beforehand at least a part of the epoxy resin with a 9, 10-dihydro-9-oxy-10-phosphaphenanthrene-10-oxide compound or the like is used or by adding the phosphorous-containing compound and modifying at least a part of the epoxy resin while hardening a phosphorous-containing epoxy hardened resin is obtained, and an adhesive sheet, a cover lay film, and metal laminate such as copper etc., having layers made from the adhesive composition.

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

International application No.
PCT/JP2004/009238

Box No. VI Certain documents cited

1. Certain published documents (Rule 43bis.1 and 70.10)

| Application No. Patent No. | Publication date (day/month/year) | Filing date (day/month/year) | Priority date (valid claim) (day/month/year) |
|-------------------------------|--------------------------------------|---------------------------------|---|
| JP 2003-298230 A | 17.10.2003 | 28.03.2002 | |
| [E, X] | | | |

2. Non-written disclosures (Rule 43bis.1 and 70.9)

| Kind of non-written disclosure | Date of non-written disclosure (day/month/year) | Date of written disclosure referring to non-written disclosure (day/month/year) |
|--------------------------------|--|---|
|--------------------------------|--|---|